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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,227	10/30/2003	Alfred F. Behrens	A-02.37	1958

7590

12/01/2004

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EXAMINER

COMSTOCK, DAVID C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/697,227	Applicant(s) BEHRENS, ALFRED F.	
	Examiner David Comstock	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 17 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-15 is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>112704</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>30 October 2003</u> . | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. Figs. 2, 3 and 4 (claims 1-10 and 12-16)
- II. Figs. 5 and 14 (claims 1, 2, 5-12 and 14-17)

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 5-10, 12, and 14-16 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Arthur Jacob on 18 November 2004 a provisional election was made without traverse to prosecute the invention of species I, claims 1-10 and 12-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11 and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, the reference to "the method of claim 11" renders the claim unclear since claim 11 does not recite a method, but rather an apparatus. For examination purposes, and as best understood, claim 16 has been considered as depending from method claim 12. It is noted that claim 17, although withdrawn from consideration, if rejoined, would likewise improperly depend from apparatus claim 11. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6, 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Palkovitz (2,812,761; cited by applicant).

Palkovitz discloses a fixation device comprising an intramedullary nail 3 having an elongate shank and a plurality of transverse sockets and passages 3a (i.e. bores) spaced from ends of the nail (see Figs. 1 and 4). Anchoring pins 7 extend through the sockets. Member 5 has passages 5a, extending normal to the longitudinal axis of the

shank, which are capable of functioning as drill guides (see Fig. 1). The member 5 is coupled to the anchoring pins, at least with respect to every degree of freedom except for translation in an axial direction of the anchoring pins.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palkovitz (2,812,761; cited by applicant) in view of Marino (4,733,654).

Palkovitz discloses the claimed invention except for the the complementary screw threads between the anchoring pins and the nail. Marino teaches a fixation device having complementary threads between pins 26, 27 and a nail 1 to allow the anchoring pins to engage the bores 24, 25, in order to stabilize the femoral nail and facilitate the healing process (see Fig. 1; col. 1, lines 5-9; and col. 3, lines 3-5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the fixation device of Palkovitz with complementary threads between the anchoring pins and the sockets of the nail, in view of Marino, in order to engage and stabilize the femoral nail and facilitate the healing process.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palkovitz (2,812,761; cited by applicant) in view of Perry (5,766,174; cited by applicant).

Palkovitz discloses the claimed invention except for explicitly disclosing that the passages may be provided at an obtuse angle with respect to the nail. Perry teaches that passages, e.g. 33, of a fixation device 20 may be oriented at an angle (including obtuse), in order to accommodate varying fractures and to better affix the bone fragments (see e.g. Fig. 6 and col. 4, lines 13-22). It would have been obvious to provide the fixation device of Palkovitz with passages at an obtuse angle with respect to the nail, in view of Perry, in order to accommodate varying fractures and to better affix the bone fragments. Moreover, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges--for example, as here, the range of optimum or workable passage angles--involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

#### ***Allowable Subject Matter***

Claims 12-15 are allowable over the prior art of record.

Claim 16 would be allowable if rewritten to depend from claim 12, as described above.

Claim 17 is subject to rejoinder and allowance if it is amended to depend from claim 12.

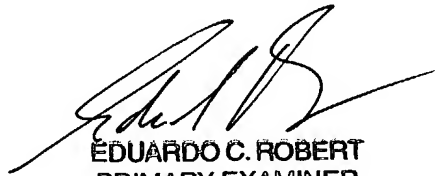
**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock  
27 November 2004



EDUARDO C. ROBERT  
PRIMARY EXAMINER